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which limitation is absent from independent claim 13. By removing the "kiosk" limitation from independent claims 1, 9 and substituting the terminology "at least one data terminal" in claim 1 and "gift registry computer system" in claim 9, Patent Owner will maintain consistency in scope among all three independent claims 1, 9 and 13 contained in the patent. Patent Owner has also added claims 15-29, which are analogous in scope to amended claims 1, 9 and original claims 2-8,10-14, to thereby recite structure that encompasses the specific embodiment of Figure 3 which was disclosed in the patent but not specifically claimed in the patent.

This Reissue Patent Application is filed within two years from the date of the original patent and the required Declaration and Consent of Patent Owner documents will be filed after the filing of the Reissue Patent Application. The enclosed specification is a copy of the patent for which reissue is requested, submitted in the form of cut up soft copies of the issued patent, with only a single column of the printed patent securely mounted on a separate sheet of paper. The claims are the only elements of the original patent that have been amended. The reissue claims are for the same invention as disclosed as being the invention in the original patent, as required by 35 U.S.C. §251, where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. §112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application.

In addition, the claims presented in the reissue application do not impermissibly recapture canceled subject matter, pursuant to the guidelines for impermissible recapture set forth by the Court of Appeals for the Federal Circuit in Clement, 131 F.3rd at 1468-69, 45 USPQ2d at 1164:

"The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. ... The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection."

In particular, the rule for impermissible recapture dictates that if the claim limitation now being omitted was originally presented to make the claims allowable over a rejection made in the original application, the omitted claim limitation relates to subject matter previously surrendered by the applicant, and impermissible recapture exists. In the original patent application, a single Office Action was issued on 20 June 1997, rejecting claims 1-14 under 35 U.S.C. §103(a) as being unpatentable over the publication article titled "Here Comes the (New) Bridal Registry" which appeared in the Chain Store Age Executive, October 1992, as well as by Applicant's admitted prior art discussed their background of the invention. In response to the 20 June 1997 Office Action, Applicant filed an amendment on 12 September 1997 and amended the independent claims 1 and 9 (but not independent claim 13) to traverse the Examiner's rejection of claims 1-14, with claim 1 being illustrative of these amendments:

1. A multi-merchant gift registry comprising:
 - a gift registry kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry, the gift registry kiosk having:
 - a first data entry system through which first information and inquiries about registrants in the gift registry are entered into the computer system the first information for each registrant including at least one name for the registrant;
 - a second data entry system capable of receiving second information, the second information including a list of potential gifts which the registrant has identified and [information about] a unique identifier associated with the particular merchant[s] having each of the desired gifts;
 - a database storage system that stores and retrieves the first and second information about the registrant[s] and the unique identifier associated with the particular merchant having each of the desired gifts;
 - and
 - a display system that displays the list of potential gifts for a particular registrant and information about the particular merchants the desired gifts are from, including the unique identifier associated with the particular merchant having each of the desired gifts, in response to an inquiry from a prospective purchaser.

These amendments define the fact that each merchant is assigned a unique identifier and the gift selected by the registrant is tied to a particular merchant who offers the selected gift, via the use of this unique identifier. In addition, Applicant added the

limitation of a kiosk for use by the registrant to input the gift and merchant data. The arguments made by Applicant in the 12 September 1997 Amendment to present these amendments were:

"The claims as amended are drawn to a gift registry that serves a plurality of merchants each having a store in a shopping area. Neither Applicants' admitted prior art nor the publication article is drawn to a registry serving a plurality of merchants, each merchant having a store in a shopping area. In fact, the publication article inferentially teaches away from the registry serving a number of stores in a shopping area. The registry in the publication article serves a number of stores under common ownership in a chain of stores. Typically the individual stores making up the chain of stores are located distant from one another in order to attract customers from a number of spatially distant areas, as distinct from the present invention in which the registry serves a number of different stores in a shopping area."

Nothing in these arguments refer to a "kiosk" and the arguments are instead directed to the distinguishing factor of a gift registry system that serves many merchants, each having a unique identifier, where the gift information is correlated with the selected merchant via the unique merchant identifier. Therefore, the substitution of "at least one data terminal" for "kiosk" in independent claim 1 and "gift registry computer system" in claim 9 maintains the distinguishing characteristics of Applicant's invention over the cited references, which is the provision of a gift registry system for a plurality of merchants, with the registrant entering registrant gift data to indicate not only the identity of the selected gift but also the unique identity of the merchant who sells the selected gift. The more general terminology of "at least one data terminal" and "gift registry computer system" is supported by the disclosure of the embodiment of Figure 3 and the associated description in column 6 of the patent. Thus, the terminology "at least one data terminal" and "gift registry computer system" is more appropriate for use in independent claims 1 and 9 than the terminology "kiosk." In addition, the limitation "kiosk" is not addressed in Applicant's arguments in the 12 September 1997 Amendment or necessary to distinguish over the cited references as evidenced by the allowed independent claim 13 which does not contain such a limitation. Therefore, the amendments to independent claims 1 and 9 do not represent impermissible recapture of canceled subject matter.

In summary, Applicant has amended claims 1, 9 and has submitted new claims

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